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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,679	02/20/2004	Arjan Dirk van Lenthe	000023.00121	5536
27557	7590	07/06/2006	EXAMINER	
BLANK ROME LLP			EASHOO, MARK	
600 NEW HAMPSHIRE AVENUE, N.W.			ART UNIT	
WASHINGTON, DC 20037			PAPER NUMBER	

1732  
DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/781,679

Applicant(s)

VAN LENTHE ET AL.

Examiner

Mark Eashoo, Ph.D.

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-29 is/are pending in the application.
- 4a) Of the above claim(s) 15-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/940,626.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/04</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Priority***

It is noted that this application appears to claim subject matter disclosed in prior Application No. 09/940,626, filed 29-AUG-2001. A reference to the prior application, and the correct status of the application, must be inserted as the first sentence(s) of the specification of this application.

***Election/Restrictions***

Applicant's election of claims 22-29 in the reply filed on 10-APR-2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 15-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected claim grouping, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 10-APR-2006.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 23 recites the broad recitation "thermoplastic material", and the claim also recites "in particular polyolefin plastics material" which is the narrower statement of the range/limitation.

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Claims 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of apparatus elements as they relate to a process limitation, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: The relationship of the groove or ribs on the expansion mandrel to the overall process.

It is submitted that to be entitled to patentable weight in method claims, recited structural limitations must affect the method in a manipulative sense and not amount to mere claiming of a use of a particular structure. See *Ex parte Pfeiffer* 135 USPQ 31. In claim 23, the above limitation appears to be a mere claiming of a use of a particular structure.

Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 25 recites the broad recitation "regular angular intervals", and the claim also recites "preferably of between 3° and 10°" which is the narrower statement of the range/limitation.

Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of apparatus elements as they relate to a process limitation, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: The relationship of the groove or ribs on the expansion mandrel to the overall process.

It is submitted that to be entitled to patentable weight in method claims, recited structural limitations must affect the method in a manipulative sense and not amount to mere claiming of a use of a particular structure. See *Ex parte Pfeiffer* 135 USPQ 31. In claim 23, the above limitation appears to be a mere claiming of a use of a particular structure.

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Claims 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 26 recites the broad recitation "thermoplastic material", and the claim also recites "in particular polyolefin plastics material" which is the narrower statement of the range/limitation.

Claims 27-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 27 recites the broad recitation "thermoplastic material", and the claim also recites "in particular polyolefin plastics material" which is the narrower statement of the range/limitation.

Claims 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where

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broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 29 recites the broad recitation "thermoplastic material", and the claim also recites "in particular polyolefin plastics material" which is the narrower statement of the range/limitation.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 22 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6,726,863. Specifically, claim 8 of U.S. Patent No. 6,726,863 substantially teaches all the instantly claimed limitations, including a step of a calibration device that reduces the external diameter of a preform/extrudate.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time

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any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 22 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art (claim 22 preamble) and Prenger et al. (US Pat. 5,817,270).

Regarding claims 22 and 25: The preamble elements are in a Jepson-type claim (i.e., a claim of the type discussed in 37 CFR 1.75(e); see MPEP § 608.01(m)) and have been interpreted as an implied admission of what is old in the art. In this case, the original specification refer to a document published years in advance of filing for this application and therefor confirms that the subject matter of the preamble was invented by another before applicant's invention and is known by the general public. Accordingly, the preamble is treated as prior art.

Applicant's admitted prior art does not teach moving the extruded preform through a calibration opening that reduces the external diameter of the extruded preform. However, Prenger et al. '270 teaches moving an extruded preform through a calibration opening that reduces the external diameter of the extruded preform (9:5-40 and Figs. 1 and 3). Applicant's admitted prior art and Prenger et al. '270 are combinable because they are from the same field of endeavor, namely, extrusion of pipes/tubes. At the time of invention a person of ordinary skill in the art would have found it obvious to have moving the extruded preform through a calibration opening that reduces the external diameter of the extruded preform, as taught by Prenger et al. '270, in the process of applicant's admitted prior art, and would have been motivated to do so in order to aid in forming a uniform preform before being drawn by the expansion part/mandrel.

Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art (claim 23 preamble) and Prenger et al. (US Pat. 5,942,171).

Regarding claims 23 and 24: The preamble elements are in a Jepson-type claim (i.e., a claim of the type discussed in 37 CFR 1.75(e); see MPEP § 608.01(m)) and have been interpreted as an implied admission of what is old in the art. In this case, the original specification refer to a document published years in advance of filing for this application and therefor confirms that the subject matter of the preamble was invented by another before applicant's invention and is known by the general public. Accordingly, the preamble is treated as prior art.

Applicant's admitted prior art does not teach grooves in an expansion mandrel through which a film of fluid is maintained between the mandrel and extruded preform. However, Prenger et al. '171 teaches grooves in an expansion mandrel through which a film of fluid is maintained between the mandrel and extruded preform (9:50-10:40). Applicant's admitted prior art and Prenger et al. '171 are combinable because they are from the same field of

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endeavor, namely, extrusion of pipes/tubes. At the time of invention a person of ordinary skill in the art would have found it obvious to have used grooves in an expansion mandrel through which a film of fluid is maintained between the mandrel and extruded preform, as taught by Prenger et al. '171, in the process of applicant's admitted prior art, and would have been motivated to do so in order to lubricate the extruded tube/preform over the expansion mandrel thereby forming a more uniform drawing of the tube/preform.

Claims 26 and 29 rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art (claim 26 preamble) and Prenger et al. (US Pat. 5,942,171).

Regarding claims 26 and 29: The preamble elements are in a Jepson-type claim (i.e., a claim of the type discussed in 37 CFR 1.75(e); see MPEP § 608.01(m)) and have been interpreted as an implied admission of what is old in the art. In this case, the original specification refer to a document published years in advance of filing for this application and therefor confirms that the subject matter of the preamble was invented by another before applicant's invention and is known by the general public. Accordingly, the preamble is treated as prior art.

Applicant's admitted prior art does not teach a plurality of drawing devices arranged sequentially to drive the extruded preform/tube at the same speed. However, Prenger et al. '171 teaches a plurality of drawing devices arranged sequentially to drive the extruded preform/tube at the same speed (4:55-65 and Fig. 1, elements 12 and 20). It is noted that one of drawing devices Prenger et al. '171 uses a series of tube engagement member that grip the tube to move the tube axially (Fig. 1, elements 14-15). Applicant's admitted prior art and Prenger et al. '171 are combinable because they are from the same field of endeavor, namely, extrusion of pipes/tubes. At the time of invention a person of ordinary skill in the art would have found it obvious to have used a plurality of drawing devices arranged sequentially to drive the extruded preform/tube at the same speed, as taught by Prenger et al. '171, in the process of applicant's admitted prior art, and would have been motivated to do so in order to move the extruded tube/preform over the expansion mandrel at a desired speed/rate.

Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art (claim 27 preamble) and Tsadares et al. (US Pat. 5,096,634).

Regarding claims 27-28: The preamble elements are in a Jepson-type claim (i.e., a claim of the type discussed in 37 CFR 1.75(e); see MPEP § 608.01(m)) and have been interpreted as an implied admission of what is old in the art. In this case, the original specification refer to a document published years in advance of filing for this application and therefor confirms that the subject matter of the preamble was invented by another before applicant's invention and is known by the general public. Accordingly, the preamble is treated as prior art.

Applicant's admitted prior art does not teach an internal support in the location that a drawing device acts. However, Tsadares et al. teaches an internal support in the location that a drawing device acts (Fig. 1, mandrel between element 13). Applicant's admitted prior art and Tsadares et al. are combinable because they are from the



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same field of endeavor, namely, extrusion of pipes/tubes. At the time of invention a person of ordinary skill in the art would have found it obvious to have used an internal support in the location that a drawing device acts, as taught by Tsadares et al., in the process of applicant's admitted prior art, and would have been motivated to do so in order to prevent undesired reshaping of the tube by a drawing device.

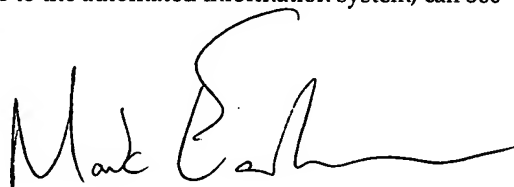
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892.

*Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Eashoo, Ph.D. whose telephone number is (571) 272-1197. The examiner can normally be reached on 7am-3pm EST, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Mark Eashoo, Ph.D.  
Primary Examiner  
Art Unit 1732

June 23, 2006  
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23 / Jun / 06